



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/530,902	04/08/2005	Graeme Semple	22578-0002US1 029.US2.PCT	2895
26204 7590 04/10/2009 FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER SAEED, KAMAL A	
			ART UNIT 1626	PAPER NUMBER
			NOTIFICATION DATE 04/10/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Office Action Summary	Application No. 10/530,902	Applicant(s) SEMPLE ET AL.	
	Examiner Kamal A. Saeed	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-6,8,9,12,13,15,16,18-20,22-24,26,27,29,30,37-39 and 43-45 is/are pending in the application.
- 4a) Of the above claim(s) 2,5,6,15,16,18-20,22-24,26,27,37-39,44 and 45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8,9,12,13,29,30 and 43 is/are rejected.
- 7) ☒ Claim(s) 1,3,4,8,9,12,13,29,30 and 43 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/24/07; 2/15/07; 1/17/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

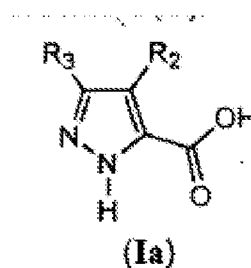
Claims 7, 10-11, 14, 17, 21, 25, 28, 31-36, 41 and 42 have been cancelled. Therefore, claims 1-6, 8-9, 12-13, 15-16, 18-20, 22-24, 26-27, 29-30, 37-39 and 43-45 are currently pending in this application. Claims 2, 5, 6, 15-16, 18-20, 22-24, 26-27, 37-39, 44 and 45 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention. The withdrawn subject matter is patentably distinct from the elected subject matter as it differs in structure and element and would require separate search considerations. In addition, a reference, which anticipates one group, would not render obvious the other.

Information Disclosure Statement

Applicant's Information Disclosure Statements, filed on January 24, 2007; February 15, 2007 and January 17, 2008 have been considered. Please refer to Applicant's copies of the 1449 submitted herewith.

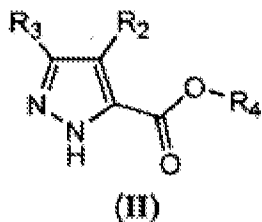
Response to Restriction

Applicants' election with traverse of Group III, claims 1, 3, 4, 8, 9, 12, 13, 29, 30



and 43 (in part), drawn to compounds of Formula Ia, or

Art Unit: 1626



wherein **R2** is a halogen or C1-C12 haloalkyl and **R3** is C1-C12alkyl and **R4** is as defined in response filed August 22, 2008 is acknowledged.

The traversal is on the ground(s) that the examiner has not provided adequate reasons and or examples to support a conclusion of patentable distinctness between the identified groups. This is not found persuasive because under PCT Rule 13.1:

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Applicant's instant claims do not relate to a single invention, the application is drawn to multiple product inventions. The multiple inventions are not so linked as to form a single general inventive concept because according to PCT Rule 13.2:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Applicant's instant claims do not contain a special technical feature that defines a contribution over the prior art. Therefore, since the substituents on the technical feature vary extensively (for example **R3** can represent heterocyclic and alkyl groups) and when taken as a whole result in vastly different compounds and unity of inventions is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper and according to PCT Rule 3.3.

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Art Unit: 1626

Therefore, since the claims do not contain a special technical feature, which defines a contribution over the prior art, the examiner may determine within a single claim that the inventions are not so linked as to form a single general inventive concept.

Further, restriction for examination purposes as indicated is proper because all the inventions listed in the Restriction Requirement action are independent or distinct for the reasons given above and in the Restriction Requirement and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

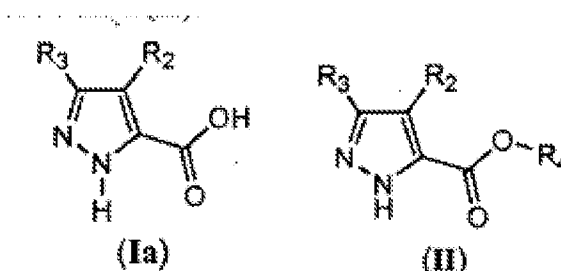
- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;
- (e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Therefore the Restriction Requirement is deemed proper and **is maintained**.

Subject matter not encompassed by elected Group I are withdrawn from further consideration pursuant to 37 CFR 1.142 (b), as being drawn to nonelected inventions.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The scope of the invention of the elected subject matter is as follows:



Compounds of formula , or , depicted in claim 1, wherein:

wherein **R₂** is a halogen or C1-C12 haloalkyl; **R₃** is C1-C12alkyl and **R₄** is as defined.

As a result of the election and the corresponding scope of the invention identified supra, the remaining subject matter of claims 1, 3, 4, 8, 9, 12, 13, 29, 30 and 43 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn compounds contain varying functional groups such as oxathiepanyl, pyrimidinyl, oxazepanyl, etc, which are chemically recognized to differ in structure and function. This recognized chemical diversity of the functional groups can be seen by the various classification of these functional groups in the U.S. classification system, i.e. class 544 subclass 106(+) (morpholine), class 546 subclass

Art Unit: 1626

249(+)(oxathiepanyl), class 540 subclass 215(+)(triazoles), 548 subclass 400(+)(pyrrolidines etc. Therefore the subject matter which are withdrawn from consideration as being non-elected subject differ materially in structure and composition and have been restricted properly a reference which anticipated but the elected subject matter would not even render obvious the withdrawn subject matter and the fields of search are not co-extensive.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections, set forth in this Office action:

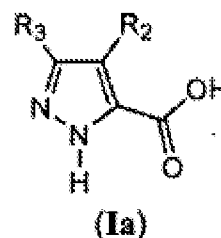
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Art Unit: 1626

Claims 1, 3, 4, 8, 9, 12, 13, 29, 30 and 43 are rejected under 35 U.S.C. 103 (3) as being unpatentable by Morgan et al., *Journal of the Chemical Society, Transaction* (1923), 123, 1308-1318.

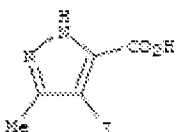


The present elected invention recites compounds of Formula, wherein **R₂** is a halogen or C1-C12 haloalkyl and **R₃** is C1-C12alkyl.

Determination of the scope and content of the prior art (MPEP §2141.01)

Morgan et al teach compound which has the chemical structure:

BN 362553-53-9 CASLUS
CN 1H-Pyrazole-5-carboxylic acid, 4-iodo-3-methyl- (CA INDEX NAME)



Ascertainment of the difference between the prior art and the claims (MPEP §2141.02)

The prior art compound that anticipates the present invention was excluded by proviso. The difference between the presently claimed invention and the prior art are they are homologs. For example in the prior art R₃ is methyl as opposed to ethyl or propyl of the current application.

Finding of prima facie obviousness--rational and motivation (MPEP §2142-2413)

MPEP 2144.08.II.A.4(c) states, "...consider teachings of a preferred species within the genus. If such a species is structurally similar to that claimed, its disclosure may motivate one of ordinary skill in the art to choose the claimed species or subgenus from the genus, based on the reasonable expectation that structurally similar species usually have similar properties."

To those skilled in the chemical art, one homologue is not an advance over a member of a homologous series. The reason for this is that one of ordinary skill, knowing the properties of one member of series, would know what properties to expect in adjacent members. The substitution of methyl with one lower alkyl such as ethyl or propyl is not a patentable modification absent unexpected or unobvious results. *In re Henze*, 85 USPQ 261 (1950), *In re Wood*, 199 USPQ 137 (CCPA 1978), and *In re Lohr*, 137 USPQ 548, 549 (CCPA 1963).

One of ordinary skill would be motivated, from the exemplified embodiments in the prior art disclosure, to make the modification required to arrive at the instant invention with reasonable expectation of success for obtaining an additional compound for the same utility. The motivation would be to make additional compounds for the same quoted purpose.

Objections

Claims 1, 3, 4, 8, 9, 12, 13, 29, 30 and 43 are objected to for containing non-elected subject matter.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kamal A Saeed, Ph.D. whose telephone number is (571) 272-0705. The examiner can normally be reached on M-T 7:00 AM- 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699.

Communication via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise requires a signature, may be used by applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or public PAIR only. For more information about the pair system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

/Kamal A Saeed/

Application/Control Number: 10/530,902

Page 10

Art Unit: 1626

Primary Examiner, Art Unit 1626